

### REMARKS

Claims 1-8 were pending. Claims 5-8 have been withdrawn from consideration as being drawn to a non-elected invention.

Claim 1 has been amended to more distinctly claim the invention and to incorporate the subject matter of claim 2. Thus, claim 2 has been cancelled.

Support for the amendments to claim 1 can be found throughout the specification as originally filed, including Figures 5 and 6. Thus, there is no new matter added as a consequence of the amendment to claim 1.

#### Restriction requirement

Applicant affirms the provisional election made by telephone on February 18, 2003, with traverse, to prosecute the invention of Group I, claims 1-4. The Examiner has withdrawn claims 5-8 from consideration.

The Office Action indicates that the inventions of Group I and II are related as process and apparatus for its practice. The Office Action also suggests that the inventions of Groups I and II are distinct because each has acquired a separate status in the art as shown by their different classification. Nevertheless, there are two criteria for a proper requirement for restriction: (1) the inventions must be independent or distinct as claimed; and (2) a search and examination of the claims would necessarily impose be a serious burden on the examiner. M.P.E.P. § 803. Indeed, if the search and examination of an entire application can be made without serious burden, the examiner must examine all claims on the merits, even though the application includes claims to independent or distinct inventions. M.P.E.P. § 803.

Applicant respectfully asserts that examination of the entire scope of claims 1-8 would not impose a serious burden on the Examiner. The process claims of Group I and the apparatus claims of Group II are so intimately related such that searching and examining the claims together would not pose a serious burden. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement in accordance with 37 C.F.R. §1.143. Applicant hereby preserves his right of petition from requirement for restriction under 37 C.F.R. § 1.144.

### 35 U.S.C. §112 Rejection

The Examiner has rejected claims 1-4 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

The Examiner alleges that claims 1-4 are directed to manufacturing a tire reinforcement but the actual positive steps defined after “said method comprising” only refer to sliding and cutting steps, and contends that this raises the potential for confusion in determining exactly what the scope of the claims are intended to be. The Examiner has suggested that claim 1 be rewritten in Jepson type format to clarify the scope of the claim. Claim 1 has been amended as recommended by the Examiner. No change in claim scope has occurred as result of this amendment.

The Examiner has also inquired on the use of the term, “passage,” in claim 2. Passage refers to the passage of the knife through the environment of the cutoff point, as it moves along the closed path. See e.g., pages 3-4, ¶¶ [0008-0009]. The number of passages is determined by the number of turns of the planet carrier. See ¶ [0022]. For example, Figure 3 illustrates the path of the knife making two passages wherein the knife is active, that

is to say, advanced to the cut-off point so as to cut the reinforcement, once every two passages. This occurs every two turns of the planet carrier. Similarly, Figure 4 illustrates the path of the knife making three passages wherein the knife is active, that is to say, advanced to the cut-off point so as to cut the reinforcement, once every three passages. This occurs every three turns of the planet carrier. ¶ [0022].

Thus, in the method according to the present invention, the knife follows a prescribed closed path (e.g. Figs. 3 & 4) and “with appropriate kinematics, arrang[es] for the knife not to be active on each passage close to the reinforcement.” ¶ [0009]

As such, one of skill in the art, looking at the specification, would understand the meaning of the term, “passage.” Applicant requests the withdrawal of the rejection of claims 1-4 under 35 U.S.C. §112, second paragraph.

#### 35 U.S.C. §102 Rejection

The Examiner has rejected claims 1-4 under 35 U.S.C. §102(b), as being anticipated by Debroche et al. (US 5,281,289) or Debroche et al. (US 5,395,476). The Examiner alleges that both references disclose methods of manufacturing tire reinforcements including sliding reinforcement in a tubular guide and applying the reinforcement on the core with cutting of the reinforcement at a cutoff point by rotation of a rotary knife rotating in closed planar path, rotation of the support continuing the cord advance and further including a roller to apply the reinforcement, which is allegedly satisfies the requirements of each of claims 1, 3 and 4.

With regard to claim 2, the Examiner alleges that the knives of the references are active every time they pass the cutoff point, and they are also active every other time they pass the cutoff point.

The applicant respectfully disagrees. Claim 1 requires that the knife be advanced to cut at the cutoff point at every  $n$  passage, wherein  $n$  is greater than or equal to two. As such, claim 1 excludes a knife that is active on every passage.

In contrast, Debroche et al. (US 5,395,476) and Debroche et al. (US 5,281,289) both teach the use of rotary cutting knives that cut the cord reinforcement with every rotation, or passage, as the knife nears the cutoff position of the cord reinforcement. Thus, the cited art require the knives cut the cord reinforcement at every  $n$  passage in the environment of the cutoff point, wherein  $n = 1$ . As stated previously, amended claim 1, excludes a knife active with every passage. The present invention requires that the knife must pass through the environment of the cutoff point at least one full rotation more than the cited art before the knife will cut the cord reinforcement.

With regard to Figure 8 of Debroche et al. (US 5,395,476), the Examiner alleges that the two knives 851 and 852 both rotate but only one is operative at a time and thus any given knife can be considered to be operative not on every passage. However, claim 1 (which incorporates the limitation of original claim 2) requires that the knife is advanced to cut at the cutoff point at every  $n$  passage in the environment of the cutoff point, wherein  $n$  is greater than or equal to two. The '476 patent does not meet this limitation. In the '476 patent, the number of required passages for cutting would relate to each knife, not the combination of the two knives during a rotation. Only one of the two knives are employed at one time. (col. 11, lines 50-65). Only knife 852 is used to lay left helix sections and only knife 851 is used to lay right helix sections. The cutting edges of the knives are oriented in opposite directions, requiring reversal of the rotation to employ the other knife. Since only one of the two sets of knives can be counted at a time, Debroche et al. (US 5,395,476) teaches the use of knives that are cutting the cord reinforcement each time the knife performs a rotation or is in the


environment of the cutoff point, not a knife that is advanced to cut at the cutoff point at every  $n$  passage in the environment of the cutoff point, wherein  $n$  is greater than or equal to two, as presently claimed. Thus, neither knife meets the claim limitation, which requires that the knife be advanced to cut at the cutoff point every  $n$  passage wherein  $n \geq 2$ . Applicant respectfully requests the withdrawal of the rejection of claims 1-4 under 35 U.S.C. §102(b).

CONCLUSION

Based on the foregoing amendments and remarks, applicant submits that the present application is in condition for allowance. A Notice of Allowance is respectfully requested. Applicant requests a two month extension of time and encloses herewith the required fee pursuant to 37 C.F.R. § 1.17(a)(2).

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication to Deposit Account No. 02-4377. A duplicate copy of this paper is enclosed.

Respectfully submitted,  
BAKER BOTTS L.L.P.

  
Richard G. Berkley  
Patent Office Reg. No. 25,465

Kimberly J. McGraw  
Patent Office Reg. No. 50,994

30 Rockefeller Plaza  
New York, NY 10012-4498

*Attorneys for Applicants*  
212-408-2500